

REMARKS

At the time of the Office Action dated March 2, 2006, claims 1-6 were pending and rejected in this application.

CLAIM 4 IS REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 4 of the Office Action, the Examiner asserted that "[t]he term 'generic' is considered broad and indefinite." This rejection is respectfully traversed.

Applicants note that the Examiner has failed to establish a prima facie case of indefiniteness under 35 U.S.C. § 112. The Examiner has merely asserted that the term "generic" is broad without establishing (a) an interpretation of the claim in light of the specification; (b) an interpretation of the claim as interpreted by one of ordinary skill in the art; and (c) that the limitation(s) in the claim does not reasonably define the invention.¹ Without the Examiner clearly defining the problem and why it is a problem in connection with the issue of claim definiteness, Applicants cannot fairly evaluate the Examiner's position. Moreover, whether or not a term is "broad" is irrelevant to the issue of indefiniteness. Applicants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claim 4, particularly when reasonably interpreted in light of the written description of the specification.² Thus, the imposed rejection of claim 4 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

¹ See M.P.E.P. § 2173.02.

² *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

**CLAIMS 1-6 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY
REQUENA ET AL., U.S. PATENT PUBLICATION NO. 2002/0126701 (HEREINAFTER REQUENA)**

On pages 2-7 of the Office Action, the Examiner asserted that Requena discloses the claimed invention corresponding to that claimed. This rejection is respectfully traversed.

In the prior Amendment, Applicants argued that:

1) The disclosure of using spatial location for use in provide a presence service does not identically disclose the claimed determining from a request a particular location-based service provider that can service the request.

2) The Examiner's reliance upon the doctrine of inherency to disclose the claimed formatting is misplaced, and that the Examiner has improperly asserted that "[f]ormatting is required since each user's device may be using a different format and multiple users are permitted within the design."

3) Independent claims 1, 3, and 5 have been amended to clarify that different ones of location-based service providers specify different formats for receiving requests and Requena fails to teaching that different ones of location-based service providers specify different formats for receiving requests because it appears that a single preferred format is used.

The Examiner responded to certain of these arguments on page 5 of the Office Action. In responding to the first argument, the Examiner asserted:

It is well known that since multiple location-based service providers exist and only one is needed to serve the request, that one of the plurality is selected.

Although cited in the prior Amendment, the Examiner is again referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof," since the Examiner has not met the requirements to establish that the missing feature is inherently disclosed by the applied prior art. The Examiner's is again making an assertion without factual support. If these "facts" are well known, then the Examiner is obligated to provide evidence of these facts.

In responding to the second argument, the Examiner asserted that:

The examiner has currently cited portions of the reference in addition to the inherency rejections. In addition, the examiner continues the inherency rejection because it is inherent in a networking design that data is converted when transferred between two networked devices.

The Examiner's assertion that "data is converted when transferred between two networked devices" again lacks factual support. The Examiner has provided no evidence for the assertion that data is necessarily converted when transferred between two networked devices. Not all data undergoes conversion when being transferred between devices. For example, if the network devices are of the same type of were intended to work together, there may not be a need to have the data transferred between the devices undergo conversion. Therefore, it is improper for the Examiner to makes this inherency argument.

The Examiner also asserted the following:

The examiner would also like to remind the applicant's representative that inherency is applied in a rejection when a feature is known in the art to be mandatory. Finally, when reading prior art, it is important to not only attain a literal interpretation of the disclosure but to also attain an understanding of the spirit of the design.

Regarding the Examiner's first assertion, the Examiner is reminded that Applicants already noted the following in the prior Amendment: "[t]o establish inherency, the extrinsic evidence must

make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill" (emphasis in original). However, despite this requirement, which the Examiner acknowledges, the Examiner has still failed to provide factual support for the necessity (or being mandatory) of the limitations that the Examiner asserts to be mandatory.

Regarding the Examiner's second assertion, Applicants request the Examiner provide case law that support the notion that the "the spirit of the design" of the applied prior art is relevant when rejecting a claim under 35 U.S.C. § 102 for anticipation.

With regard to the third argument (i.e., the amendments to the claims in the prior Amendment), these amendments have been completely ignored by the Examiner. By ignoring these claim limitation, the Examiner has committed clear legal error.³ Moreover, the Examiner is referred to M.P.E.P. § 707.07(f), which states that "the Examiner, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Applicants have argued that these features were not identically disclosed by Requena, but the Examiner has not responded to these arguments.

Therefore, for the reasons stated above, Requena fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102. Thus, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-6 under 35 U.S.C. § 102 for anticipation based upon Requena.

³ Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971); In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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